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OFFICE OF PETITIONS

[10191/1917]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Hans-Joerg MATHONY #12
Serial No. : 09/960,571
For : DEVICE FOR CONTROLLING/REGULATING THE
OPERATIONAL SEQUENCES IN A MOTOR VEHICLE
Examiner : Crystal J. Barnes
Group Art Unit : 2121
Confirmation No. : 5723

I hereby certify that this correspondence is being deposited with
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Alexandria, VA 22313-1450, on

Date 2/17/04

Atty's Reg. # 41,172

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Atty's Signature

LG Magistre
**DERVIS MAGISTRE
KENYON & KENYON**

**REQUEST FOR RECONSIDERATION OF DECISION TO
DISMISS REQUEST TO ACCORD A FILING DATE OF
SEPTEMBER 12, 2001 AND PETITION UNDER 37 C.F.R. § 1.183**

S I R:

This Request for Reconsideration is filed in response to the dismissal by the Commissioner of Applicant's request to accord a filing date of September 12, 2001 to the above-referenced application. This paper explains that Applicant has fully complied with the requirements of 37 C.F.R. § 1.6(e) by promptly filing the application after the ending of the postal service interruption and by submitting a statement that, but for the postal service interruption caused by the World Trade Center attacks of September 11, 2001, the application would have been filed no later than September 12, 2001. Applicant therefore respectfully requests reconsideration of the Decision dismissing Applicant's request for a filing date of September 12, 2001 and respectfully requests that the present application be accorded a filing date of September 12, 2001. In the alternative, Applicant petitions under 37 C.F.R. § 1.183 for suspension or waiver of the showing allegedly required by 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e) to accord a filing date of September 12, 2001 to the present application.

REMARKS

In its dismissal of Applicant's request to recognize September 12, 2001 as the filing date of the above-referenced application, the United States Patent and Trademark Office acknowledges that the Office designated the interruption in the service of the United States Postal Service in the borough of Manhattan as a postal service interruption and emergency within the meaning of 35 U.S.C. § 21(a), with the provisions of 37 C.F.R. 1.6(e) in effect, and that the Office designated the interruption in the Express Mail service of the United States Postal Service as a postal service interruption within the meaning of 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e). The Decision also acknowledges that Applicant's request asserts that the application papers would have been filed on September 12, 2001 if it were not for the United States Postal Service interruption and emergency.

The Decision contends at page 2 that "[t]he statute requires that (1) the application papers being filed must be complete and ready to be deposited with the USPS on the filing date requested by applicant, and (2) the complete application papers could not be deposited with the USPS for the sole reason that the postal service was not available due to the interruption or emergency designated by the Office." Applicant respectfully disagrees. Furthermore, Applicant respectfully submits that the request fully complies with the requirements of 35 U.S.C. § 21(a), to the extent that it applies to Applicant, and Applicant respectfully submits that the request fully complies with the requirements of 37 C.F.R. § 1.6(e).

According to the Office, the justification for requiring proof that "the application papers being filed must be complete and ready to be deposited with the USPS on the filing date requested by applicant" arises from "[t]he statute," i.e., 35 U.S.C. § 21(a). Applicant respectfully disagrees. The statute specifically states that "[t]he Director may by rule prescribe that any paper or fee required to be filed in the [PTO] will be considered filed in the Office on the date it . . . would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director" (emphasis added). The express words of the statute do not impose on Applicant the obligation to submit proof that the Office contends is contained in the statute. The statute is an enabling piece of legislation that authorizes the Director to prescribe rules governing the process by which papers submitted after a particular date will be considered filed as of that date. This statute does not impose any substantive requirements on Applicants, since neither

patent applicants nor any individual(s) other than the Director are mentioned in the statute. Instead, the statute is concerned only with the powers of the Director with respect to filing dates and dates for taking action. In particular, the statute states that “[t]he Director may by rule prescribe” the manner by which “any paper . . . will be considered filed in the Office.” Id. (emphasis added). The use of the permissive “may” and mandatory “will” in this manner indicates that Congress intended to leave it up to the Director to decide how applicants can show entitlement to a filing date that is earlier than the actual date of receipt at the Office. This interpretation finds support in the legislative history of the statute, reproduced below:

A new subsection (a) has been added to section 21 of title 35 to authorize, but not require, the [Director] to give as the filing date of any paper or fee which is required to be filed in the Patent and Trademark Office the date on which the paper or fee was deposited with the United States Postal Service. The [Director] may also give as the filing date of any paper or fee which was required to be filed in the Patent and Trademark Office the date it would have been deposited with the United States Postal Service but for postal service interruptions or emergencies which the [Director] designates. The requirements governing whether any given paper or fee may be given the filing date of the day on which it was, or would have been, deposited with the United States Postal Service will be set forth in regulations established by the [Director].

H.R. Rep. 97-542, 1982 U.S.C.C.A.N. 765, 775 (emphasis added). The statute itself does not impose any requirements on patent applicants at all, since the purpose of this law is to “authorize” the Director to give as the filing date of papers or fees the date such papers or fees were actually, or would have been, deposited with the United States Postal Service. As expressly stated in the legislative history quoted above, “the requirements governing whether any given paper or fee may be given the filing date of the day on which it was, or would have been, deposited with the United States Postal Service will be set forth in regulations established by the [Director].” Id. Congress thus left it to the discretion of the Director to decide whether to impose on patent applicants the requirement of proof that is now claimed by the Office to exist. In promulgating 37 C.F.R. § 1.6(e), the Director could have opted for a mandatory proof requirement, but the Director chose not to, deciding instead to merely require that Applicants submit a statement indicating that such correspondence would have been filed on a particular date if it were not for the

designated interruption or emergency in the United States Postal Service. Quite simply, the statute does not support the requirement that the Office now seeks to impose on Applicant.

The rule, i.e., 37 C.F.R. § 1.6(e), states that the "Office will consider as filed on a particular date in the Office any correspondence which is . . . (1) [p]romptly filed after the ending of the designated interruption or emergency; and . . . (2) [a]ccompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service" (emphasis added). The "Statement Under 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e)" states that "in accordance with 37 C.F.R. § 1.6(e), the attached correspondence is being filed promptly after the ending of the designated interruption[, and the] attached correspondence would have been filed on September 12, 2001 if it were not for the U.S. Postal Service interruption and emergency." Since Applicant has fully complied with the letter of 37 C.F.R. § 1.6(e), as well as with the spirit and scope of 37 C.F.R. § 1.6(e), it is respectfully submitted that the Office must accord the present application a filing date of September 12, 2001 as required by 37 C.F.R. § 1.6(e).

Notwithstanding the above, in the interest of facilitating the prosecution of this application, Applicant submits herewith a "Statement of Dervis Magistre in Support of Request For Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition Under 37 C.F.R. § 1.183," which sets forth that the application papers deposited with the United States Postal Service on September 21, 2001 were "complete and ready to be deposited with the USPS on the filing date[, i.e., September 12, 2001,] requested by applicant." In view of the foregoing, it is respectfully submitted that Applicant has provided sufficient proof that "the application papers [deposited with the United States Postal Service on September 21, 2001 were] complete and ready to be deposited with the USPS on the filing date[of September 12, 2001] requested by applicant" and that the complete application papers could not be deposited with the USPS for the reason that the postal service was not available due to the interruption or emergency designated by the Office. In view of the foregoing, it is respectfully submitted that sufficient proof has been provided that "the application was ready to be deposited with the USPS on September 12, 2001 but all post offices in the area were closed

due to the events of September 11, 2001." Accordingly, it is respectfully requested that a filing date of September 12, 2001 be accorded to the present application.

In the alternative, Applicant respectfully petitions under 37 C.F.R. § 1.183 for suspension or waiver of the alleged requirements of 37 C.F.R. § 1.6(e) and 35 U.S.C. § 21(a). It is respectfully submitted that the events of September 11, 2001, which directly precipitated Applicant's inability and failure to deposit the application papers with the United States Postal Service on the filing date requested, i.e., September 12, 2001, constitute "an extraordinary situation" under 37 C.F.R. § 1.183, and it is respectfully submitted that justice requires that the Office accord a filing date of September 12, 2001 to the present application. Applicant therefore respectfully petitions under 37 C.F.R. § 1.183 that the alleged requirements of 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e) be suspended or waived so that a filing date of September 12, 2001 can be accorded to the present application and that a filing date of September 12, 2001 be accorded to the present application. The Commissioner is authorized to charge the fee under 37 C.F.R. § 1.17(h), as well as any other fees that may be required in accordance with this paper, to the deposit account of Kenyon & Kenyon, Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated: 2/17/04

By:



Gerard A. Messina
Reg. No. 35,952

One Broadway
New York, NY 10004
(212) 425-7200



[10191/1917]

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Date 2/17/04

Atty's Reg. # 41,172

Atty's Signature

Derwis Magistre
DERVIS MAGISTRE
KENYON & KENYON

**STATEMENT OF DERVIS MAGISTRE IN SUPPORT OF
REQUEST FOR RECONSIDERATION OF DECISION TO
DISMISS REQUEST TO ACCORD A FILING DATE
OF SEPTEMBER 12, 2001 AND PETITION UNDER 37 C.F.R. § 1.183**

S I R:

I, **DERVIS MAGISTRE**, in support of the "Request For Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition under 37 C.F.R. § 1.183" in connection with the above-captioned application, state as follows:

1. I am associated with the law firm of Kenyon & Kenyon.
2. I was personally responsible for preparing the above-captioned application for filing in the United States Patent and Trademark Office.
3. I had completed the application papers, i.e., the four pages of Specification, the one page containing five claims, the one page of Abstract, and the

two pages of Figures, that were deposited with the United States Postal Service on September 21, 2001, no later than September 12, 2001.

Respectfully submitted,

Dated: 2/17/04

By: Dervis Magistre
Dervis Magistre
Reg. No. 41,172

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